

All communications respecting this case should identify it by number and names of parties.



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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MAILED

MAR 22 1996

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Applicant: Skoultchi
Serial No.: 08/102,390
Filed: 08/05/93
For: PRODUCTION OF PROTEINS
USING HOMOLOGOUS RECOMBINATION
Accorded Benefit: Application
07/787,390, filed 11/04/91
(ABN); Application 07/432,069,
filed 11/06/89 (ABN)

The case referred to above has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with other cases hereafter specified. Attention is directed to the fact that this interference is declared pursuant to 37 CFR 1.601 et seq., effective February 11, 1985 (49 Fed. Reg. 48,416 (1984); 1050 Off. Gaz. Pat. & Trademark Office 385 (Jan. 29, 1985)), and amendments effective April 21, 1995. See Notice of Final Rule, 60 Fed. Reg. 14,488 (1995), reprinted in 1173 Off. Gaz. Pat. & Trademark Office 36 (Apr. 11, 1995). A clean copy of the interference rules, as amended, appears at 1173 Off. Gaz. Pat. & Trademark Office 384 (Apr. 18, 1995). The interference is designated as No. 103,737.

By direction of the Commissioner of Patents and Trademarks and as required by 35 USC 135(c), notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference."

Filed by: APJ Adriene Lepiane Hanlon
Box Interference
Washington, D.C. 20231
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

SCOTT C. CHAPPEL

Junior Party,¹

v.

ARTHUR I. SKOULTCHI

Senior Party.²

Patent Interference No. 103,737

NOTICE DECLARING INTERFERENCE
(37 CFR § 1.611)

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application, patent, count, and claims designated to correspond to the count appear in an "Attachment" to this order.

¹ Patent 5,272,071, granted December 21, 1993, based on Application 07/893,447, filed May 28, 1992.

² Application 08/102,390, filed August 5, 1993.

Judge designated to handle the interference

Administrative Patent Judge (APJ) Adriene Lepiane Hanlon has been designated to handle the interference. 37 CFR § 1.610.

Telephone Conference Calls

Any questions regarding this interference shall be addressed, in the first instance, to the Administrators of the Board of Patent Appeals and Interferences (Board), Merrell C. Cashion, Jr. and Dale M. Shaw (703-308-9797). Conference calls with the APJ must be arranged in advance with the Administrators indicating to them the issues proposed for discussion and the reasons a conference call is necessary. Lead or backup counsel for all parties must participate in any conference calls with the APJ.

The parties are reminded that ex parte contact with the assigned APJ or any other APJ of the Board on matters related to this interference is inappropriate. Questions related to "procedural" or "practice" matters shall only be raised by conference call or may be directed to the Administrators of the Board.

Notice under 35 U.S.C. § 135(c)

Notice is hereby given of the requirement of 35 U.S.C. § 135(c) for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference."

ORDER

Upon consideration of the application and patent involved in this interference, it is:

Lead and backup counsel

ORDERED that within **20 days** of the date of this order each party shall file a separate paper identifying a lead counsel and a backup counsel for lead counsel, as well as the mailing address, telephone numbers and facsimile (fax) number for both lead counsel and backup counsel (37 CFR § 1.613(a)); no contact should be made with the undersigned by anyone other than the lead counsel or backup counsel, and it is

Real party in interest

FURTHER ORDERED that within **20 days** of the date of this order each party shall file a separate paper notifying the Board of "any and all right, title, and interest in any application or patent involved or relied upon in the interference unless the right, title, and interest is set forth in the notice declaring the interference" (37 CFR § 1.602(b)), and it is

Size of paper

FURTHER ORDERED that all papers (e.g., identification of lead counsel, identification of real party in interest, motions, preliminary motions, preliminary statements, briefs, etc.) filed in this interference shall be on 8½ x 11 paper (with the possible exception of original exhibits); papers of a different size, including legal size papers, shall not be filed, and it is

Holes at the top of papers

FURTHER ORDERED that all papers filed in this interference proceeding, except for exhibits, briefs and record for final hearing, shall have two holes spaced 2 and 3/4 inches apart punched at the top center of each page (each hole spaced equidistant from an imaginary center line running from the top to the bottom of the page) so that the papers may be placed in interference files maintained by the Patent and Trademark Office, and it is

Headings to be used on papers filed in the interference

FURTHER ORDERED that in all papers filed with the Board in this interference on behalf of either party the heading shown in the attached Appendix 1 shall be used, and it is

Prohibition against presenting duplicate papers

FURTHER ORDERED that when presenting a paper in this interference, counsel shall not submit with the paper (as an appendix, exhibit, or otherwise) a copy of a paper previously filed in the interference (37 CFR § 1.618(b)), and it is

Service of papers by hand or Express Mail

FURTHER ORDERED that all papers served on opposing counsel in this interference shall be served by Express Mail (a one-day delivery service of the U.S. Postal Service) (37 CFR § 1.646(d)); alternatively counsel may serve opposing counsel using any means which accomplishes a one-day delivery, e.g., by hand, fax, or a commercial one-day delivery service, and it is

Filing of papers in the Patent and Trademark Office

FURTHER ORDERED that the parties may use the U.S. Postal Service to send papers and other materials related to this interference to the Patent and Trademark Office. When using the U.S. Postal Service the following address shall be used:

BOX INTERFERENCE
Commissioner of Patents and Trademarks
Washington, D.C. 20231

The parties may also hand deliver papers and other material to the Patent and Trademark Office. When hand delivery is used, delivery directly to the Board at the following location is encouraged:

Board of Patent Appeals and Interferences
Crystal Gateway 2
1225 Jefferson Davis Highway
10th floor
Arlington, Virginia 22202

In the case of a commercial one-day delivery service (i.e., Federal Express), the above-noted Crystal Gateway address should be used.

The parties may also forward papers to the Board via fax at 703-308-7953. If a paper is forwarded by fax a confirmation copy shall not be filed (37 CFR § 1.618(b)), and it is

Preliminary motions

FURTHER ORDERED that in view of the prosecution history of at least one involved file, all 35 U.S.C. § 112, first paragraph, issues will be addressed first in this interference proceeding. Therefore, on or before **May 31, 1996** each party is required to demonstrate how his own claims which have been

designated as corresponding to the count are (1) enabled and (2) descriptively supported in his respective involved application or patent AND all benefit applications identified in the attachment to this declaration notice. Failure of a party to address these 35 U.S.C. § 112, first paragraph, issues at this time will estop that party from addressing these same issues at a later time during this interference proceeding;

the time for filing preliminary motions under 37 CFR §§ 1.633(a) and (g) for the limited purpose of addressing enablement and descriptive support under 35 U.S.C. § 112, first paragraph, is set to expire on **May 31, 1996**; no other motions are to be filed at this time;

the time for filing oppositions to these preliminary motions under 37 CFR §§ 1.633(a) and (g) is set to expire on **June 20, 1996**;

the time for filing replies to the oppositions to these preliminary motions under 37 CFR §§ 1.633(a) and (g) is set to expire on **July 10, 1996**;

failure of a party to file preliminary motions under 37 CFR §§ 1.633(a) and (g) for the limited purpose of addressing the above-identified enablement and descriptive support issues under 35 U.S.C. § 112, first paragraph, will estop that party from filing such preliminary motions at a later time during this interference proceeding.

Please be advised that copies of involved patent and application files and benefit patent and application files can

only be obtained by placing an order through the Certification Division of the Patent and Trademark Office (703-308-9726 in the Washington, D.C., Metro Area and 800-972-6382 outside Washington, D.C.). Availability of Interference Files and Interference Related Application and Patent Files, 1184 Off. Gaz. Pat. & Trademark Office 15 (Mar. 5, 1996). Please be further advised that there is a delay in obtaining such files through the Certification Division. Therefore, orders should be placed promptly, and it is

"Combined" oppositions not to be filed

FURTHER ORDERED that an opposition shall only respond to a single preliminary motion; "combined" oppositions responding to more than one preliminary motion shall not be filed, and it is

"Combined" replies not to be filed

FURTHER ORDERED that a reply shall only respond to a single opposition; "combined" replies to more than one opposition shall not be filed, and it is

Time and manner of filing exhibits

FURTHER ORDERED that exhibits referred to in preliminary motions, oppositions, replies or affidavits should be identified by exhibit numbers (not letters) on a label placed in the lower right-hand corner of the first page of the exhibit.

Compare 37 CFR § 1.653(i). If important material is covered by an exhibit label on the first page of the exhibit, a copy of the first page of the exhibit may be reproduced and presented as page 1-a of the exhibit. All exhibits must be legible. If the

exhibit is handwritten, a typed copy of the exhibit must be attached to the handwritten copy. Exhibits should be labeled as follows:

Exhibit [Number]
NAME OF PARTY IN CAPITAL LETTERS
Interference No. 103,737

All original exhibits should be submitted in an accordion type or other folder containing all exhibits in numerical order, the idea being that each preliminary motion, opposition, reply or affidavit shall refer to the exhibit by number. The objective of this practice is to avoid the filing of multiple copies of the same exhibit only because an exhibit is referred to in more than one preliminary motion, opposition, reply or affidavit.

An exhibit relied upon in connection with preliminary motions, oppositions, replies, and affidavits shall be served (but not filed) with the preliminary motion, opposition, reply or affidavit in which the exhibit is first mentioned.

All exhibits relied upon in connection with preliminary motions filed under 37 CFR §§ 1.633(a) and (g) and any oppositions, replies or affidavits related thereto shall be filed together in the Patent and Trademark Office on or before **July 10, 1996**, and it is

Preliminary Statements

FURTHER ORDERED that the time for filing preliminary statements (37 CFR § 1.621(a), see also 37 CFR § 1.627(a)) is set to expire on **May 31, 1996**;

the notice required by 37 CFR § 1.621(b) shall be filed and served on or before **May 31, 1996**.



ADRIENE LEPIANE HANLON
Administrative Patent Judge

Enclosures:

Appendix 1
Attachment

**INTERFERENCE
DIGEST**

Interference No. 103,737 Paper No. 35
Name, Arthur I. Skoultchi
Serial No. 08/102,390 Patent No. _____
Title, PRODUCTION OF PROTEINS USING HOMOLOGOUS RECOMBINATION
Filed, 08/05/93
Interference with Chappel

DECISION ON MOTIONS

Examiner-in-Chief, _____ Dated, _____

FINAL DECISION

Board of Patent Appeals and Interferences, _____ Dated, _____

Court, _____ Dated, _____

REMARKS

This should be placed in each application or patent involved in interference in addition to the interference letters.